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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,363	04/12/2004	Christopher Ronnewinkel	13906-163001/2004P00100US	3080

32864 7590 04/06/2007
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EXAMINER

HWANG, JOON H

ART UNIT	PAPER NUMBER
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2166

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/822,363

Applicant(s)

RONNEWINKEL ET AL.

Examiner

Joon H. Hwang

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/22/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. The applicants amended claims 1, 5, 8, and 16-18 in the amendment filed on 1/3/07.

The claims 1-18 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. Claim 16 is objected to because of the following informalities:
 - "a first business process step" in 14th line of claim 16 should be "a second business process step"; and
 - "the first business process step" in 16th line of claim 16 should be "the second business process step,".

Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is directed to a method of retrieving responses to a received message. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete and tangible result. Specifically, the claimed subject matter does not produce a tangible result when the first and second modules are not executed because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides for a final result of retrieving responses to a received message. This produced result remains in the abstract, and thus, fails to achieve the required status of having real world value. Claim 2-16 are likewise rejected.

Claim 17 is directed to a method of performing multiple steps in an Interaction Center business process. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete and tangible result. Specifically, the claimed subject matter does not produce a tangible result when the email editor and ERMS modules are not executed because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides for a final result of performing multiple steps in an Interaction Center business process. This produced result remains

in the abstract, and thus, fails to achieve the required status of having real world value.

Claim 18 is likewise rejected.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5, 9-12, and 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Pak et al. (U.S. Publication No. 2004/0260534).

With respect to claim 1, Pak teaches retrieving responses to a received message (abstract and fig. 2). Pak teaches analyzing content of a received message (i.e., message analysis engine 140 in fig. 2B, sections 55-58 on page 5). Pak teaches selecting one or more categories in a categorization scheme such that each of the selected one or more categories relates to the content of the received message, each selected category having response information linked thereto (sections 55-58 on page 5, section 41 on page 3, fig. 2B). Pak teaches if a first of a plurality of predefined computer-executable response modules is executed during performance of a first business process step, executing the first module by retrieving from electronic data storage at least a first part of the response information linked to the selected category

and using the retrieved response to perform the first business process step (i.e., automated message response, fig. 2B and sections 55-58 on page 5). Pak teaches if a second of the plurality of predefined computer-executable response modules is executed during performance of a second business process step, executing the second module by retrieving from electronic data storage at least a second part of the response information linked to the selected category and using the retrieved response information to perform the second business process step, wherein the first and second business process steps are different steps of a business process (i.e., training feedback, sections 64-67 on page 6 and fig. 3B).

With respect to claim 2, Pak teaches displaying suggested response message content on a display device, the suggested content being included in the linked response information (section 37 on page 3).

With respect to claim 3, Pak teaches the suggested content includes at least one document (section 41 on page 3).

With respect to claim 4, Pak teaches the suggested content includes at least one response template (section 21 on page 2 and section 41 on page 3).

With respect to claim 5, Pak teaches receiving user commands to send a response message with the suggested content (section 37 on page 3).

With respect to claim 9, Pak teaches the first module is one that produces a response message, and the second module is one that executes a procedure other than producing a response message (figs. 2B and 3B, sections 55-58 on page 5 and sections 64-67 on page 6).

With respect to claim 10, Pak teaches the first part is an auto-response (fig. 2B and sections 55-58 on page 5).

With respect to claim 11, Pak teaches the first part involves suggested content (fig. 2B, sections 55-58 on page 5, and section 37 on page 3).

With respect to claim 12, Pak teaches the other procedure is service related (sections 37-38 on page 3, section 45 on page 4, and section 74 on page 7).

With respect to claim 14, Pak teaches the first and second parts of the linked response information are different (figs. 2B and 3B, sections 55-58 on page 5 and sections 64-67 on page 6).

With respect to claim 15, Ronnewinkel teaches the received message comprises an email (section 68 on page 6).

The limitations of claim 16 are rejected in the analysis of claim 1 above, and the claim is rejected on that basis.

8. Claims 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Ronnewinkel et al. (U.S. Publication No. 2004/0083191).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

With respect to claim 17, Ronnewinkel teaches receiving an email having content that relates to one of a plurality of predetermined categories in a categorization scheme, each predetermined category having business objects linked thereto (abstract, fig. 5, sections 6-14 on page 1, and sections 22-23 on page 2). Ronnewinkel teaches selecting one or more categories from among the plurality of predetermined categories (sections 6-14 on page 1 and sections 31-36 on page 3). Ronnewinkel teaches receiving user input that identifies which of a plurality of response procedure modules are to be executed in response to the received email (fig. 5, sections 6-14 on page 1, sections 31-36 on page 3). Ronnewinkel teaches if an email editor module is executed, using a response template selected from among the business objects linked to the selected category (fig. 5, sections 6-14 on page 1, sections 31-36 on page 3). Ronnewinkel teaches if an ERMS (e-mail response management system) module is executed, suggesting at least one business object linked to the selected category, the suggested business object including at least one of a quick solution document and an expert selected from among the business objects linked to the selected category (fig. 5, sections 6-14 on page 1, sections 31-36 on page 3).

With respect to claim 18, Ronnewinkel teaches executing one of the email editor and ERMS modules involves displaying suggested response message content on a display device, the suggested content being included in the linked response information (fig. 4, fig. 5, sections 6-14 on page 1, sections 31-36 on page 3).

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9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being obvious over Pak et al. (U.S. Publication No. 2004/0260534) in view of Gainey et al. (U.S. Patent No. 6,941,304).

With respect to claim 6, Pak discloses the claimed subject matter as discussed above except executing a message routing instruction that routes the received electronic message to a user's email account, the message routing instruction being included in the linked response information. However, Gainey teaches executing a message routing instruction that routes the received electronic message to a user's email account, the message routing instruction being included in the linked response information ("Categorizing Email Messages" section in cols. 6-9) in order to efficiently handle a large volume of incoming email messages (lines 42-45 in col. 1). Therefore, based on Pak in view of Gainey, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Gainey to the system of Pak in order to efficiently handle a large volume of incoming email messages.

With respect to claim 7, Pak discloses the claimed subject matter as discussed above except executing a message routing instruction that routes the received electronic message to a user's email account, the message routing instruction being included in the linked response information. However, Gainey teaches executing a

message routing instruction that routes the received electronic message to a user's email account, the message routing instruction being included in the linked response information ("Categorizing Email Messages" section in cols. 6-9) in order to efficiently handle a large volume of incoming email messages (lines 42-45 in col. 1). Therefore, based on Pak in view of Gainey, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Gainey to the system of Pak in order to efficiently handle a large volume of incoming email messages.

With respect to claim 8, Gainey further teaches an electronic message account of an expert (fig. 1 and lines 33-42 in col. 7). Therefore, the limitations of claim 8 are rejected in the analysis of claim 7 above, and the claim is rejected on that basis.

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being obvious over Pak et al. (U.S. Publication No. 2004/0260534) in view of Haigh (U.S. Patent No. 5,793,861).

With respect to claim 13, Pak discloses the claimed subject matter as discussed above except the service-related procedure involves scheduling a service order. However, Haigh teaches the service-related procedure involves scheduling a service order (fig. 2, fig. 6, and lines 25-40 in col. 7) in order to handle a business transaction. Therefore, based on Pak in view of Haigh, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Haigh to the system of Pak in order to handle a business transaction.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joon H. Hwang whose telephone number is 571-272-4036. The examiner can normally be reached on 9:30-6:00(M~F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Joon Hwang
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Technology Center 2100

3/30/07